

### REMARKS/ARGUMENTS

In response to the Restriction Requirement mailed on January 23, 2006, (Paper No. 01052006), the applicant elects, with traverse, the claims of Group II. That is, the applicant elects, with traverse, claims 10, 13, 22, 25-28 and 33.

The applicant respectfully submits that the Restriction Requirement is improper because there is no serious burden as required by MPEP 803 and because the Groups of claims are not related as combination and sub-combinations as alleged by the Examiner. Each of these issues is addressed below.

#### ***Improper Conclusion as to Groups being Combination and Sub-combinations***

The Examiner concludes that the claims of Group I are a combination of sub-combinations of Groups II and III. (See Paper No. 01052006, page 2.) This is incorrect. MPEP 806.05(a) provides that a "combination is an organization *of which a subcombination* or element *is a part*." (Emphasis added.) The claims of Groups II and III are not parts of the claims of Group I.

Even if the claims of Group I were a combination, MPEP 806.05(a) specifies that if a restriction is to be made, the claims of the combination must be assumed to be allowable, *in the absence of a holding by the Examiner to the contrary*. Although the applicant contends that the claims of Group I are allowable for the

reasons set forth in the amendment dated October 27, 2005, the Examiner has rejected these exact claims. Since the Examiner has held that the claims of the combination are not allowable, the restriction is improper. If, however, upon reconsideration, the Examiner holds the claims of Group I to be allowable, the Examiner should state this in any further action.

***No Serious Burden***

MPEP 803 provides that if the search and examination of the application can be made without serious burden, the Examiner *must* examine it on the merits, even if it may include claims to independent or distinct inventions. In this instance, the Examiner has already examined the subject matter of the pending claims and has addressed the pending claims in earlier office actions. The applicant assumes that these office actions were complete as required by MPEP 707 and 37 C.F.R. § 1.104.

Further, the Restriction Requirement misclassified the claims into separate subclasses of claims 709. All of the claims pertain to comparing configurations of a device, such as a data forwarding device for example. Even assuming, arguendo, that the Restriction Requirement properly classified the claims, the applicant respectfully notes that the Examiner already searched both class 709, subclass 220 (into which the claims of Group III were classified) and class 709, subclass 238 (into

which the claims of Group II were classified).  
(See the "SEARCHED" section of the file wrapper  
initialed by the Examiner (copy enclosed).)

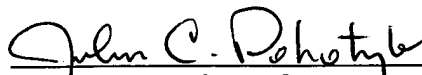
In summary, the Restriction Requirement  
misclassifies the groups of claims (which all  
pertain to comparing configurations of a device)  
into separate subclasses of class 709. Even if  
the classification of the groups of claims is  
proper, there would be no serious burden on the  
Examiner to examine all of the pending claims  
because (1) the subclasses into which the  
Examiner classified the claims of Groups II and  
III were already searched by the Examiner and (2)  
the Examiner already examined all of the pending  
claims.

**Conclusion**

In view of at least the foregoing reasons,  
the applicant respectfully submits that the  
Restriction Requirement is improper on a variety  
of grounds and should be withdrawn.

Respectfully submitted,

February 23, 2006

  
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CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being deposited on **February 23, 2006** with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
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